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REMARKS

This Amendment is in response to the Office Action dated September 12, 2005. In the Office Action, claims 1-9, 17, 19 and 20 were rejected under 35 USC §101 and claims 1-23 were rejected under 35 USC §102. By this Amendment, claims 1, 9, 17, 18 and 23 are amended, claims 24 and 25 are added, and claims 20 and 22 are canceled. Currently pending claims 1-19, 21 and 23-25 are believed allowable, with claims 1, 9 and 23 being independent claims.

CLAIM REJECTIONS UNDER 35 USC §101:

Claims 1-8, 17, 19 and 20 were rejected under 35 USC §101 as allegedly directed to non-statutory subject matter. According to the Examiner, claims 1-8, 17, 19 and 20 "are rejected under 35 U.S.C. 101 as not being tangible since the steps of the method do not require use of hardware or computer system to accomplish the steps." The Applicant respectfully submits that it is immaterial whether claim limitations may be performed by some or all steps that are carried out by a human for purposes of evaluating statutory subject matter.

Claims are not directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of a human or because it may be necessary for one performing the processes to do some or all of the process steps. "We cannot agree with the board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think." *In re Musgrave*, 431 F.2d 882, 893, 167 USPQ 280, 289-90 (emphasis added). If all the steps of a claimed process can be carried out in the human mind, examiners must determine whether the claimed process produces a useful, tangible, and concrete result, i.e., apply the practical application test set forth in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). See *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, pp. 46-47 (Oct. 26, 2005) (http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

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For at least this reason, claims 1-8, 17, 19 and 20 are believed to be directed to statutory subject matter.

Independent claim 9 was also rejected 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. As support for this rejection, the Office Action states, "... elements or features of the claimed Machine can be implemented by software alone." The Applicant respectfully submits that claim 9 is directed to "an information providing apparatus", not a software program as alleged by the Examiner. Furthermore, the Applicant respectfully submits that 35 U.S.C. §101 does not limit patentable subject matter to inventions whose elements or features cannot be implemented by software alone. For at least this reason, claim 9 is believed to be directed to statutory subject matter.

CLAIM REJECTIONS UNDER 35 USC §102:

Claims 1-23 were rejected under 35 USC §102 as being anticipated by U.S. Patent No. 6,275,988 issued to Nagashima et al. ("Nagashima"). To anticipate a claim under 35 USC §102, a reference must teach every element of the claim. MPEP 2131.

Claim 1

Claim 1 is amended to incorporate all the subject matter of claim 20 (now cancelled). Thus, claim 1 is an independent form of claim 20. Claim 1 recites, in part, "generating a finite number of intermediate contents for content that corresponds to an entire body of information, wherein said intermediate contents are hieratically structured according to the number of pages contained therein."

In rejecting claim 20, the Office Action alleges that Nagashima teaches providing a description of the amount of information contained in said finite number of intermediate contents, citing column 17, lines 16 to 23 as support for this allegation. The Application respectfully disagrees with the Office Action's interpretation of Nagashima.

Column 17, lines 16 to 23 of Nagashima state, "A facsimile apparatus 1804 is connected to the ATM network and LAN. A color printer 1805 has an internal page memory. A color copying machine 1806 includes a color scanner and a color printer. The color copying machine 1806 also includes a page

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memory for storing image data of an original read by the color scanner, and a circuit for reading out data written in the page memory and supplying the readout data to the printer." It is respectfully submitted that the citation offered in the Office Action does not describe or suggest to someone versed in the art intermediate contents that are hieratically structured according to the number of pages contained therein. Furthermore, the Applicant submits that Nagashima does not teach or suggest the limitation intermediate contents hieratically structured according to the number of pages contained therein.

Thus, for at least this reason, claim 1 is allowable over Nagashima. Allowance of claim 1 is therefore earnestly solicited.

Claims 2-8:

Claims 2-8 are dependent on and further limit claim 1. Since claim 1 is believed allowable, claims 2-8 are also believed allowable for at least the same reasons as claim 1.

Claim 17

Claim 17 is dependent on claim 1 and is amended to recite, "The information providing method according to claim 1, further comprising associating a content price for each of the intermediate contents based on the number of pages contained therein." Support for this amendment can be found at least at Figure 16.

The Applicant submits that Nagashima does not teach or suggest to someone versed in the art associating a content price for each of the intermediate contents based on the number of pages contained therein.

Thus, for at least this reason, and the reason offered for claim 1, claim 17 is allowable over Nagashima. Allowance of claim 17 is therefore earnestly solicited.

Claim 19

Claim 19 is dependent on claim 1 and is amended to recite, "The information providing method according to claim 1, further comprising providing a grammatical description of the amount of information contained in said finite number of intermediate contents." Support for this claim

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amendment can be found at least at Figs. 11 and 12 of the present Application.

In rejecting claim 19, the Office Action alleges that Nagashima teaches providing a description of the amount of information contained in said finite number of intermediate contents, citing Figure 3 and column 7, lines 47 to 3 as support for this allegation. The Application respectfully submits, however, that Nagashima does not teach or suggest a grammatical description of the amount of information contained in said finite number of intermediate contents.

In Figure 3 of Nagashima, a table is shown with three columns. The first column contains the heading "Title of Information" and includes the entries "Info 1" and "Info 2". Thus, it is apparent that the contents of the first column merely contain the title of the image stored, and not a grammatical description of the information contained in the image. The second and third columns of this figure also fail to teach grammatically describing the information contained in the image. Turning to the cited text, Nagashima states, "FIG. 3 shows an example of a charge table stored in the storage unit 102. In the charge table shown in FIG. 3, for example, information Info 1 incurs charge 11 when it is provided at resolution 1, incurs charge 12 when it is provided at resolution 2, . . ." Nagashima, col. 7, ln. 59-63. Here, again, there is no teaching or suggest to someone versed in the art of grammatically describing the information contained in the image.

Thus, for at least this reason, and the reason offered for claim 1, claim 19 is allowable over Nagashima. Allowance of claim 19 is therefore earnestly solicited.

Claim 9

Claim 9 is amended to incorporate all the subject matter of claim 22 (now cancelled). Thus, claim 9 is an independent form of claim 22. Claim 9 recites, in part, "wherein said intermediate contents are hieratically structured according to the number of pages contained therein."

In rejecting claim 22, the Office Action alleges that Nagashima teaches providing a description of the amount of information contained in said finite

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number of intermediate contents, citing column 17, lines 16 to 23 as support for this allegation. The Application respectfully disagrees with the Office Action's interpretation of Nagashima.

Column 17, lines 16 to 23 of Nagashima state, "A facsimile apparatus 1804 is connected to the ATM network and LAN. A color printer 1805 has an internal page memory. A color copying machine 1806 includes a color scanner and a color printer. The color copying machine 1806 also includes a page memory for storing image data of an original read by the color scanner, and a circuit for reading out data written in the page memory and supplying the readout data to the printer." It is respectfully submitted that the citation offered in the Office Action does not describe or suggest to someone versed in the art intermediate contents that are hieratically structured according to the number of pages contained therein. Furthermore, the Applicant submits that nowhere in Nagashima is there a teaching or suggestion of intermediate contents hieratically structured according to the number of pages contained therein.

Thus, for at least this reason, claim 9 is allowable over Nagashima. Allowance of claim 9 is therefore earnestly solicited.

Claims 10-15:

Claims 10-15 are dependent on and further limit claim 9. Since claim 9 is believed allowable, claims 10-15 are also believed allowable for at least the same reasons as claim 9.

Claim 18

Claim 18 is dependent on claim 9 and is amended to recite, "The information providing apparatus according to claim 9, further comprising a price storage unit configured to associate a content price for each of the intermediate contents based on the number of pages contained therein." Support for this amendment can be found at least at Figure 16.

The Applicant submits that Nagashima does not teach or suggest to someone versed in the art associating a content price for each of the intermediate contents based on the number of pages contained therein.

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Thus, for at least this reason, and the reason offered for claim 9, claim 18 is allowable over Nagashima. Allowance of claim 18 is therefore earnestly solicited.

Claim 21

Claim 21 is dependent on claim 9 and is amended to recite, "The information providing apparatus according to claim 9, further comprising means for providing a grammatical description of the amount of information contained in said finite number of intermediate contents." Support for this claim amendment can be found at least at Figs. 11 and 12 of the present Application.

In rejecting claim 21, the Office Action alleges that Nagashima teaches providing a description of the amount of information contained in said finite number of intermediate contents, citing Figure 3 and column 7, lines 47 to 3 as support for this allegation. The Application respectfully submits, however, that Nagashima does not teach or suggest a grammatical description of the amount of information contained in said finite number of intermediate contents.

In Figure 3 of Nagashima, a table is shown with three columns. The first column contains the heading "Title of Information" and includes the entries "Info 1" and "Info 2". Thus, it is apparent that the contents of the first column merely contain the title of the image stored, and not a grammatical description of the information contained in the image. The second and third columns of this figure also fail to teach grammatically describing the information contained in the image. Turning to the cited text, Nagashima states, "FIG. 3 shows an example of a charge table stored in the storage unit 102. In the charge table shown in FIG. 3, for example, information Info 1 incurs charge 11 when it is provided at resolution 1, incurs charge 12 when it is provided at resolution 2, . . ." Nagashima, col. 7, ln. 59-63. Here, again, there is no teaching or suggest to someone versed in the art of grammatically describing the information contained in the image.

Thus, for at least this reason, and the reason offered for claim 9, claim 21 is allowable over Nagashima. Allowance of claim 19 is therefore earnestly solicited.

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Claim 23

Claim 23 is amended to recite, in part, "wherein said intermediate contents are hieratically structured according to the number of pages contained therein." As discussed above for claims 1 and 9, nowhere in Nagashima is there a teaching or suggestion of intermediate contents hieratically structured according to the number of pages contained therein. Thus, for at least this reason, claim 23 is allowable over Nagashima. Allowance of claim 23 is therefore earnestly solicited.

Claims 24 and 25:

Claims 24 and 25 are dependent on and further limit claim 23. Since claim 9 is believed allowable, claims 24 and 25 are also believed allowable for at least the same reasons as claim 23.


CONCLUSION

In view of the forgoing remarks, it is respectfully submitted that this case is now in condition for allowance and such action is respectfully requested. If any points remain at issue that the Examiner feels could best be resolved by a telephone interview, the Examiner is urged to contact the attorney below.

No fee is believed due with this Amendment, however, should such a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Respectfully submitted,

Dated: December 12, 2005



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